UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,174	08/13/2001	Brian Minear	010239	8995

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EXAMINER
PERSINO, RAYMOND B

ART UNIT	PAPER NUMBER
2682	

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/929,174	MINEAR ET AL.
	Examiner	Art Unit
	Raymond B. Persino	2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .	6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1, 3-5, 10, 13, 14, 17, 22-24, 26, 31 and 34 are rejected under 35

U.S.C. 102(e) as being anticipated by Puhl et al (US 6,223,291 B1).

Regarding claim 1, Puhl et al discloses a system for controlling software

applications on one or more wireless devices, comprising: one or more wireless devices

(11 of fig 1), each wireless device in selective communication with a wireless network

(19 of fig 1) and having one or more resident software applications selectively

executable on the wireless device, each software application requiring a license for

each execution of the software application, and upon the attempted execution of a

software application, the wireless device determining if a license is present to execute

the software application; one or more application managing servers, each application

managing server selectively communicating with the one or more wireless devices

across the wireless network and selectively providing a license for the use of a software

application; and wherein, upon the attempted execution of a software application on the

wireless device for which a license is not present, the wireless device selectively

prompting the application managing server for transmission of a license, receiving the

transmitted license, and installing the license on the wireless device such that the

licensed software application is executable (column 6 lines 17-39 and column 7 lines

45-61).

Regarding claim 3, see the rejection of the parent claim concerning the subject

matter this claim is dependent upon. Puhl et al further discloses that the application

managing server also selectively downloads software applications and the requisite

license for the software applications to wireless devices over the wireless network

(column 6 lines 17-39 and column 7 lines 25-43).

Regarding claim 4, see the rejection of the parent claim concerning the subject

matter this claim is dependent upon. Puhl et al further discloses the application

managing server stores the license for execution of a specific software application on a

specific wireless device, and upon the attempted execution of a software application on

a wireless device, the wireless device selectively prompting the application managing

server for transmission of a copy of the license (column 7 lines 1-11).

Regarding claim 5, see the rejection of the parent claim concerning the subject

matter this claim is dependent upon. Puhl et al further discloses that the wireless

device stores the license for execution of a specific software application on the wireless

device (column 6 lines 17-39).

Regarding claim 10, see the rejection of the parent claim concerning the subject matter this claim is dependent upon. Puhl et al further discloses that the wireless device is a cellular telephone (column 2 line 45).

Regarding claim 13, Puhl et al discloses a system for controlling software applications on a wireless network, comprising: wireless communication means for selectively communicating with a wireless network and having one or more resident software applications selectively executable thereon, each software application requiring a license for each execution of the software application, and upon the attempted execution of a software application, the wireless communication means determining if a license is present to execute the software application; software application managing means for managing software applications on one or more wireless communication means, the software application managing means selectively in communication across the wireless network with the wireless communication means and selectively providing a license for the use of a software application; and wherein, upon the attempted execution of a software application on the wireless communication means for which a license is not present, the wireless communication means selectively prompting the software application managing means for transmission of a license, receiving the transmitted license, and installing the license on the wireless communication means such that the licensed software application is executable (column 6 lines 17-39 and column 7 lines 45-61).

Regarding claim 14, Puhl et al discloses a method for controlling software applications on one or more wireless devices, each wireless device in selective

communication with a wireless network and having one or more resident software

applications selectively executable on the wireless device and one or more software

applications requiring a license for each execution of the software application, and the

one or more wireless devices in selective communication with one or more application

managing servers across the wireless network, the method comprising the steps of:

attempting to execute a software application upon a wireless device; determining if a

license is present for the wireless device to execute the software application; and if a

license is not present, then the steps of: selectively prompting the application managing

server from the wireless device for transmission of a license; selectively transmitting a

license from the application managing server to the wireless device; receiving the

transmitted license at the wireless device; and installing the license on the wireless

device such that the licensed software application is executable (column 6 lines 17-39

and column 7 lines 45-61).

Regarding claim 17, see the rejection of the parent claim concerning the subject

matter this claim is dependent upon. Puhl et al further discloses that the determining if

a license is present for the wireless device to execute the software application is

determining at the application managing server if a license is present for the wireless

device to execute the software application (column 6 lines 16-39 and column 7 lines 25-

61).

Regarding claim 22, see the rejection of the parent claim concerning the subject

matter this claim is dependent upon. Puhl et al further discloses selectively transmitting

a license from the application managing server to the wireless device is selectively

transmitting a copy of a license for the software application of the wireless device held

at the application managing server (column 7 lines 1-11).

Regarding claim 23, Puhl discloses a method for controlling software applications

on one or more wireless devices, each wireless device in selective communication with

a wireless network and having one or more resident software applications selectively

executable on the wireless device and one or more software applications requiring a

license for each execution of the software application, and the one or more wireless

devices in selective communication one or more application managing servers across

the wireless network, the method comprising the steps of: an execution attempt step for

attempting to execute a software application upon a wireless device; a licensing

determination step for determining if a license is present for the wireless device to

execute the software application; and if a license is not present, then the steps of: a

license transmission-prompting step for selectively prompting the application managing

server from the wireless device for transmission of a license; a transmission step for

selectively transmitting a license from the application managing server to the wireless

device; a license receipt step for receiving the transmitted license at the wireless device;

and a license installation step for installing the license on the wireless device such that

the licensed software application can be executed (column 6 lines 17-39 and column 7

lines 45-61).

Regarding claim 24, Puhl discloses a wireless device in selective communication

with a wireless network and having one or more resident software applications

selectively executable on the wireless device, one or more of the resident software

applications requiring a license for each execution of the software application, and upon

the attempted execution of a software application, the wireless device determining if a

license is present to execute the software application, the wireless device in selective

communication with one or more application managing servers across the wireless

network, and upon the attempted execution of a software application on the wireless

device for which a license is not present, the wireless device selectively prompts the

application managing server for transmission of a license, receives the transmitted

license, and installs the license such that the software application is executable (column

6 lines 17-39 and column 7 lines 45-61).

Regarding claim 26, see the rejection of the parent claim concerning the subject

matter this claim is dependent upon. Puhl et al further discloses that the wireless

device stores the license for execution of a specific software application on the wireless

device (column 6 lines 17-39).

Regarding claim 31, see the rejection of the parent claim concerning the subject

matter this claim is dependent upon. Puhl et al further discloses that the wireless

device is a cellular telephone (column 2 line 45).

Regarding claim 34, Puhl discloses a computer readable medium, a program that

directs a wireless device having a computer platform and in selective communication

with a wireless network, the wireless device further having one or more resident

software applications selectively executable on the wireless device with at least one

software application requiring a license for each execution of the software application, to

perform the steps of: attempting to execute a software application upon the wireless

device; determining if a license is present for the wireless device to execute the

software application; and if a license is not present, then the steps of: selectively

prompting, from the wireless device, an application managing server on the wireless

network for transmission of a software application license; receiving the transmitted

software application license at the wireless device; and installing the license on the

wireless device such that the licensed software application is executable (column 6 lines

17-39 and column 7 lines 45-61).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 2, 15, 16 and 25 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Puhl et al (US 6,223,291 B1) in view of Byrne (US 6,223,288 B1).

Regarding claim 2, see the rejection of the parent claim concerning the subject

matter this claim is dependent upon. However, Puhl et al does not disclose that upon

the attempted execution of a software application for which a license is not present,

prompts the user of the wireless device to obtain the requisite license for execution of

the software application. Byrne discloses upon the attempted execution of a software

application for which a license is not present, prompts the user of the wireless device to

obtain the requisite license for execution of the software application (abstract).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to prompt a user for a license upon attempted execution of software. This allows the unlicensed software to be loaded on the device such that all that is needed is the license. This saves time over having to download and license the application.

Regarding claim 15, see the rejection of the parent claim concerning the subject matter this claim is dependent upon. However, Puhl et al does not disclose that upon the attempted execution of a software application for which a license is not present, prompting the user of the wireless device to obtain the requisite license for execution of the software application. Byrne discloses upon the attempted execution of a software application for which a license is not present, prompts the user of the wireless device to obtain the requisite license for execution of the software application (abstract). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to prompt a user for a license upon attempted execution of software. This allows the unlicensed software to be loaded on the device such that all that is needed is the license. This saves time over having to download and license the application.

Regarding claim 16, see the rejection of the parent claim concerning the subject matter this claim is dependent upon. However, Puhl et al does not disclose that the determining is made at the wireless device if a license is present for the wireless device to execute the software application. Byrne discloses that the determination is made at the device if a license is present for the device to execute the software application

(column 3 lines 35-51). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made have the determination made at the device if a license is present for the device to execute the software application. This eliminates the need for the device to communicate with the application manager to determine if it has a license. Thus communications resources would be conserved.

Regarding claim 25, see the rejection of the parent claim concerning the subject matter this claim is dependent upon. However, Puhl et al does not disclose that upon the attempted execution of a software application for which a license is not present, prompts the user of the wireless device to obtain the requisite license for execution of the software application. Byrne discloses upon the attempted execution of a software application for which a license is not present, prompts the user of the wireless device to obtain the requisite license for execution of the software application (abstract). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to prompt a user for a license upon attempted execution of software. This allows the unlicensed software to be loaded on the device such that all that is needed is the license. This saves time over having to download and license the application.

5.   Claims 6-9, 11, 12, 18-21, 27-30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puhl et al (US 6,223,291 B1) in view of an examiner's official notice.

Regarding claims 6-9, see the rejection of the parent claim concerning the subject matter this claim is dependent upon. Puhl et al suggests finite duration licenses

but does not do so with detail (column 8 lines 18-25). Nevertheless the examiner takes

official notice that is was known in the art at the time the invention was made to issue

licenses of a) a finite duration and expires on a fixed date; b) wherein the license

expires after a predetermined number of executions of the software application on the

wireless device; c) wherein the license is of a finite duration and expires after the elapse

of a predetermined duration since the software application was downloaded to the

wireless device; and d) wherein the license is of a finite duration and expires after the

elapse of a predetermined duration of usage of the software application. Therefore it

would have been obvious to a person of ordinary skill in the art at the time the invention

was made to have a license of finite duration. The most significant advantage of a

license of finite duration is that it could be provided to a user at a reduced cost thus

allowing a user to need to only pay for his/her use of the application.

Regarding claims 11 and 12, see the rejection of the parent claim concerning the

subject matter this claim is dependent upon. Puhl et al suggests that the client device is

a wireless device (column 2 lines 45-46). However, Puhl et al does not specifically

indicate that the wireless device is a personal digital assistant or a pager. Nevertheless,

the examiner takes official notice that it was well known at the time the invention was

made that a personal digital assistant can be a wireless device and that a pager is a

wireless device. Therefore it would have been obvious to a person of ordinary skill in

the art at the time the invention was made to have a license of finite duration. Allowing

a PDA for pager to be used with the invention of Puhl et al will enhance the teaching of

Puhl et al by expanding the number and type of devices that the teaching can be used with.

Regarding claims 18-21, see the rejection of the parent claim concerning the subject matter this claim is dependent upon. Puhl et al suggests finite duration licenses but does not do so with detail (column 8 lines 18-25). Nevertheless the examiner takes official notice that is was known in the art at the time the invention was made to determine if a license expired based upon either a) the passage of a fixed date; b) a predetermined number of executions of the software application on the wireless device; c) predetermined duration since the software application was downloaded to the wireless device; and d) predetermined duration of usage of the software application. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine if a license expired based upon of finite duration. The most significant advantage of a license of finite duration is that it could be provided to a user at a reduced cost thus allowing a user to need to only pay for his/her use of the application.

Regarding claims 27-30, see the rejection of the parent claim concerning the subject matter this claim is dependent upon. Puhl et al suggests finite duration licenses but does not do so with detail (column 8 lines 18-25). Nevertheless the examiner takes official notice that is was known in the art at the time the invention was made to issue licenses of a) a finite duration and expires on a fixed date; b) wherein the license expires after a predetermined number of executions of the software application on the wireless device; c) wherein the license is of a finite duration and expires after the elapse

of a predetermined duration since the software application was downloaded to the wireless device; and d) wherein the license is of a finite duration and expires after the elapse of a predetermined duration of usage of the software application. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have a license of finite duration. The most significant advantage of a license of finite duration is that it could be provided to a user at a reduced cost thus allowing a user to need to only pay for his/her use of the application.

Regarding claims 32 and 33, see the rejection of the parent claim concerning the subject matter this claim is dependent upon. Puhl et al suggests that the client device is a wireless device (column 2 lines 45-46). However, Puhl et al does not specifically indicate that the wireless device is a personal digital assistant or a pager. Nevertheless, the examiner takes official notice that it was well known at the time the invention was made that a personal digital assistant can be a wireless device and that a pager is a wireless device. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have a license of finite duration. Allowing a PDA for pager to be used with the invention of Puhl et al will enhance the teaching of Puhl et al by expanding the number and type of devices that the teaching can be used with.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Russell et al (US 2002/0049679 A1) discloses a secure digital content licensing system and method.

Biddle et al (US 2002/0107809 A1) discloses a system and method for licensing management.

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond B. Persino whose telephone number is (703) 308-7528. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian C. Chin can be reached on (703) 308-6739. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Raymond B. Persino
Examiner
Art Unit 2682

RP
August 11, 2003

VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600
8/11/03